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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/576,706

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Saskia Lehmann

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FACTOR & LAKE, LTD
1327 W. WASHINGTON BLVD.
SUITE 5G/H
CHICAGO, IL 60607

EXAMINER

SELLERS, ROBERT E

ART UNIT

PAPER NUMBER

1796

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DELIVERY MODE

06/25/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/576,706	Applicant(s) LEHMANN ET AL.	
	Examiner ROBERT SELLERS	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 June 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-27 is/are pending in the application.
- 4a) Of the above claim(s) 12-16 and 24-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-11 and 17-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. Claims 12-16 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected inventions, there being no allowable generic or linking claim. The election was made **without** traverse in the non-Final rejection mailed December 18, 2009.

2. Newly submitted claims 24-27 are directed to inventions that are distinct from the invention originally claimed for the following reasons:

Claims 1, 3-11 and 17-23 and new claims 24-27 are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product, and the species are patentably distinct (MPEP § 806.05(j)). In the instant case, the intermediate product is deemed to be useful as a molding formulation and the inventions are deemed patentably distinct because there is nothing of record to show them to be obvious variants.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 24-27 withdrawn from consideration as being directed to non-elected inventions (37 CFR 1.142(b) and MPEP § 821.03).

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3. The individual concentrations of the components defined in new claims 24 and 26 are not supported by the tables on pages 17 and 19 of the specification, respectively, since each amount is specific to a particular type of component possessing a singular structure or chemical formula which does not substantiate the generically claimed stabiliser, first polysiloxane defoamer, second polysiloxane defoamer, first photoinitiator, second photoinitiator, co-initiator, pigment and expxoy resing [sic] solution in HDDA.

4. The term “epoxy resin” is misspelled in claims 24-27.

5. Claims 25 and 27 contains trade names. Where a trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph (*Ex parte Simpson*, 218 USPQ 1020, Bd. App. 1982). The claim scope is uncertain since the trade name cannot be used properly to identify any particular material or product. A trade name is used to identify a source of goods, and not the goods themselves. Thus, a trade name does not identify or describe the goods associated with the trade name.

6. In the present case, the trade names are used to identify certain species of 1,6-hexanediol diacrylate, stabilizer, first polysiloxane defoamer, second polysiloxane defoamer, first photoinitiator, second photoinitiator, co-initiator, epoxy resin solution, nano-silicon dioxide, MMA copolymer solution and acid-modified polyester acrylate. Accordingly, the identifications are indefinite.

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The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3 and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. The limitations of claims 3 and 18 are indistinguishable. Therefore, the same subject matter is claimed twice.

The text of the basis for obviousness-type double patenting and sections 102(b), 102(e) and 103(a) of Title 35, U.S. Code not included in this action can be found in the non-Final rejection.

Claims 1, 3-11 and 17-23 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 8, 9, 12, 13, 15-17 and 24 of copending application no. 11/649,728. Although the conflicting claims are not identical, they are not patentably distinct from each other for the reasons of record set forth in the non-Final rejection.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The arguments filed June 18, 2010 have been considered but are unpersuasive.

8. Independent claims 1, 18, 22 and 23 do not preclude the wax required in the claims of the copending application.

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9. The language of independent claims 1, 18 and 22 directed to “[a] glass printing ink or glass printing lacquer” merely states the intended use of the claimed composition and is not a limitation thereto (MPEP § 2111.02 II. Preamble Statements Reciting Purpose or Intended Use and Pitney Bowes, Inc. v. Hewlett Packard Co., 51 USPQ2d 1161,1165, Federal Circuit 1999). The printing ink or lacquer does not imbue the ensuing blend of components with any structure or properties distinguishing it from the formulations of Komiyama et al. Patent No. 5,118,567; Noguchi et al. Patent No. 5,476,752; Xu Publication No. 2007/0149667, European Patent No. 1,086,403 and Oka et al. Patent No. 6,485,885. There is no limitations pertaining to the viscosity, particle size of pigments, bonding requirements of the ink to a printing substrate and/or drying or curing requirements of the ink film applied to a printing substrate to distinguish the claimed combination of components from those set forth in the aforementioned references applied hereinbelow.

Claims 1, 3-6, 17, 18-20 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Komiyama et al. Patent No. 5,118,567.

The rejection is maintained for the reasons of record set forth in the non-Final rejection. The arguments filed June 18, 2010 have been considered but are unpersuasive.

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10. Independent claims 1, 18 and 22 do not require a two-component composition, but merely a mixture of components including a bisphenol A epoxy resin diluted in a UV hardening monomer. The Epikote 1001 bisphenol A epoxy resin in the presence of an epoxy acrylate or polyester acrylate disclosed and shown in Komiyama et al. (col. 2, lines 7-12; col. 4, lines 28-34 and col. 7, Example 1) is within the ambit of the claims since the epoxy acrylate or polyester acrylate is of a sufficiently low molecular weight such as the epoxy acrylate having a molecular weight of 730 in Example 1 to inherently dilute the bisphenol A epoxy resin.

11. The claims are directed to a mixture of components wherein the UV hardening monomer and other resin are together and not required to be kept apart.

Claims 1, 3-8 and 17-22 rejected under 35 U.S.C. 102(b) as being anticipated by Noguchi et al. Patent No. 5,476,752.

Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Noguchi et al.

The rejections are maintained for the reasons of record set forth in the non-Final rejection. The arguments filed June 18, 2010 have been considered but are unpersuasive.

12. The claimed other resin generic to a free amino groups-containing resin embraces the amino-functional linear methacrylate polymer LP-1 shown in Example 4 in column 22 and described in column 18, lines 38-43.

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13. The instant specification on page 8, line 26 identified amines as a suitable co-initiator of claim 10, thereby encompassing the amino compounds listed in column 15, lines 63-67 regardless of their designation as photopolymerization accelerators.

14. The composition of Noguchi et al. is useful in solution form (col. 4, lines 61-62) exhibiting excellent adhesion to glass (col. 1, lines 13-16) further containing dyes or pigments (col. 16, lines 55-56 and 62-65), all features inherent in the claimed intended use as a glass printing ink or lacquer.

Claim 17 is rejected under 35 U.S.C. 102(e) as being anticipated by Xu Publication No. 2007/0149667, European Patent No. 1,086,403 and Oka et al. Patent No. 6,485,885.

The rejection is maintained for the reasons of record set forth in the non-Final rejection. The arguments filed June 18, 2010 have been considered but are unpersuasive.

15. The claimed compositions do not preclude the aliphathic epoxies of Xu, especially considering the permissibility for including liquid epoxy resins disclosed on page 7, lines 17-18 of the instant specification.

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16. The European patent on page 5, lines 2-3 designates diglycidyl ethers of bisphenol A as an especially preferred species of cationically curable compound (page 4, paragraph 24). The blend of a1) a glycidyl ether of a polyhydric alcohol having at least three epoxy groups and a2) an alicyclic epoxide set forth on page 3, paragraph 11 is a specific permutation of the cationically curable compound wherein the broadest sense of thereof recited on page 4, paragraph 24 is not limited thereto.

17. The composition of the European patent is formulated as a liquid (page 14, paragraph 99) including pigments and dyes (page 13, line 24), all features inherent in the claimed intended use as a glass printing ink or lacquer.

The claims are directed to a composition and not its method of preparation. Thus, the thermal curing step disclosed in column 23, lines 62-65 since the composition exists as a liquid coating formulation prior to any further treatment. (col. 23, lines 49-52).

18. The composition of Oka et al. utilized as a liquid coating containing coloring agents (col. 20, lines 48-51) contains all of the features inherent in the claimed intended use as a glass printing ink or lacquer.

Claims 1, 3-11, 18-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over European Patent No. 1,086,403 in view of Knell Patent No. 5,346,933 and Kamen et al. Patent No. 5,656,336

Claims 1 and 4-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Xu Publication No. 2007/0149667 and Oka et al. Patent No. 6,485,885 in view of Knell and Kamen et al.

Xu and Oka et al. have been separated from the European patent since claims 3 and new claims 18-23 wherein the other resin is limited to a melamine acrylate, acid-modified polyester acrylate and/or epoxy acrylate in claims 3 and 18-22, or a melamine acrylate and/or acid-modified polyester acrylate in claim 23 is not recited.

Otherwise, the rejections are maintained for the reasons of record set forth in the non-Final rejection. The arguments filed June 18, 2010 have been considered but are unpersuasive.

19. The European patent on page 6, line 2 describes GT series solid bisphenol A epoxy resins embracing the Araldite GT 7072 described on page 4, line 24 of the instant specification. Xu discloses (page 1, paragraph 15, line 3) and exemplifies (page 7, Table 1, Epon 825) a bisphenol A epoxy resin. Oka et al. (col. 15, line 66 to col. 16, line 3) also reports GT series bisphenol A epoxy resins. Accordingly, the primary references recite bisphenol A epoxy resins.

20. Knell and Kamen et al. are applied as secondary references teaching the motivation for using the disclosed bisphenol A epoxy resins of the primary references and need not set forth each of the claimed components. The motivation for employing bisphenol A epoxy resins possessing molecular weights of 1075 (Knell, col. 6, Examples 1 and 2, Epon 1001F and Polysciences, Inc. data sheet) or from 800-1200 (Kamen et al., col. 4, lines 6-8) as the bisphenol A epoxy resins of the primary references in order to enhance the adhesion to glass is a viable objective consistent with the liquid formulations thereof.

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The amendment necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL** (MPEP § 706.07(a)). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

(571) 272-1093 (Fax No. (571)-273-8300)
Monday to Friday, 9:30 to 6:00

/Robert Sellers/
Primary Examiner
Division 1796

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6/24/2010